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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/795,987	03/10/2004	Fumiuki Suzuki	Q78014	2238
23373	7590	05/21/2007	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			RONESI, VICKEY M	
		ART UNIT	PAPER NUMBER	
		1714		
		MAIL DATE	DELIVERY MODE	
		05/21/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/795,987	SUZUKI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Vickey Ronesi	1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 06 March 2007.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The specification and claim objections are withdrawn in light of applicant's amendment filed on 3/6/2007.
2. No new grounds of rejection are set forth below. Thus, the following action is properly made final.

#### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.
4. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khemani et al (US 6,573,340) in view of Wilson et al (US 5,017,629) and Akiyama et al (US 5,412,003).  
The rejection is adequately set forth in paragraph 3 of Office action mailed on 11/7/006 and is incorporated here by reference.

#### ***Response to Arguments***

5. Applicant's arguments filed 3/6/2007 have been fully considered but they are not persuasive. Specifically, applicant argues (A) that the object of the invention of Khemani is to obtain a film with good elongation and an excellent dead-fold property, which is different from the present invention's improvements regarding heat resistance and specific weight; (B) that Khemani does not contain polylactic acid as the main component of the biodegradable plastic resin; (C) that Khemani does not exemplify a composition with hollow glass spheres and glass

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fibers; and (D) that the elongation at break of Khemani will be decreased by adding glass spheres.

With respect to argument (A), although the object of the invention of Khemani is to obtain a film with good elongation and excellent dead-fold property, case law holds that it “does not alter the conclusion that its use in a prior art composition would have been *prima facie* obvious from the purpose disclosed in the reference.” *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

With respect to argument (B), Khemani teaches that polylactic acid is the main component in the biodegradable polymer contains stiff and soft biodegradable polymers. Note especially Khemani’s claim 8 (col. 24, lines 57-63) which states that the biodegradable polymer includes 50-98 wt % of the stiff polymer, i.e., polylactic acid.

With respect to argument (C), case law holds that it is perfectly proper for the examiner to look to the whole reference for what it teaches rather than merely rely on preferred embodiments. *In re Courtright* 153 USPQ 735 (CCPA 1967).

With respect to argument (D), Khemani promotes the use of hollow glass spheres in col. 15, line 16 as a useful inorganic filler in its biodegradable polymer blends. It fails to disclose or suggest a detrimental effect on its invention by adding hollow glass spheres.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

5/16/2007  
Vickey Ronesi

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